

Remarks:

In the December 22, 2004, Office Action, Claims 1-30 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Kolling et al. (U.S. Patent No. 5,963,925) in view of Krouse et al. (U.S. Patent No. 6,097,834).

Applicants' invention is a method and system for electronically presenting bills which method and system are capable of accepting and processing paper bills which are received from billers on behalf of customers by a service provider. Paper bills are converted into electronic bills by scanning them into electronic images and extracting billing information from the electronic images. The billing information which is so extracted is then validated. The extracted and validated billing information is then electronically presented to the customer. The present invention provides a unique electronic bill presentment method and system which method and system are capable of dealing with paper bills generated by goods or service providers and presenting these bills to customers electronically, optionally together with bills which are generated by goods or service providers as electronic bills. As such, the system of the present invention is advantageous over prior art bill presentment systems capable of presenting only bills supplied by billers as electronic bills.

Applicants believe that the Section 103(a) rejection of Claims 1-30 is incorrect for at least three separate and distinct reasons, each of which requires the removal of the rejection of the claims:

1. First, the December 22, 2004, Office Action does not provide a reason to make the combination of two markedly different and completely unrelated references; it is well established that in order to establish a prima facie case of obviousness the Examiner must present evidence that would have led one of ordinary skill in the art to arrive at the claimed invention, and the December 22, 2004, Office Action fails to do so;
2. Second, in the December 22, 2004, Office Action a number of allegations are made by the Examiner as to portions of the claims that are allegedly obvious without citing any prior art showing those limitations; unless and until the Examiner is qualified as an expert in the field, this practice is absolutely impermissible as well as being indicative of the fact that the prior art indeed does not teach the claimed invention; and
3. Third, the art cited in the December 22, 2004, Office Action still fails to teach multiple limitations which are clearly present in the claims; in this regard, the December 22, 2004, Office Action substantially misrepresents what the cited references, particularly the Krouse et al. reference, teach.

Brief Discussion of the References Cited

A brief review of the cited references is illustrative of the fact that while they each may contain one or more key words which are contained in Applicants' claims, they fail to teach Applicants' invention. Upon an examination of the cited references, it is apparent that they are concerned with issues which are completely unrelated to each other as well as being unrelated to Applicants' invention, and the only reason for combining

them is that Applicants' claims teach a combination of elements some of which elements are present (but used for an unrelated purpose) in one or the other of the cited references. This use of the claimed invention as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art represents an impermissible use of hindsight.

The Kolling et al. Patent. The Kolling et al. patent is an electronic bill presentment system which is only capable of accepting electronic billing information from billers and presenting it electronically to consumers. The Kolling et al. reference simply does not work with paper bills, and does not use paper statements or invoices in any way; in fact, there is not a single word in the entire Kolling et al. reference which deals with the issue of paper bills. Rather, the Kolling et al. reference "replaces the preparation and mailing of paper statements and invoices from a biller with electronic delivery." Abstract, lines 1-2 (emphasis added). The electronic statements, when displayed on the consumer's computer, have the same look as paper bills would have had (or formerly had).

The Krouse et al. Patent. The Krouse et al. reference is a walk-in bill payment system in which a customer brings a paper bill and physically walks into a location having a terminal for the walk-in bill payment system. As such, it is a completely manual bill payment system which is incapable of presenting bills to customers, and which is electronic only in that payment to the biller is made by the walk-in bill payment system through the ACH/EFT system. The customer must bring a paper bill to the facility

having the walk-in bill payment system terminal. The bill is scanned by the walk-in bill payment system terminal and if the walk-in bill payment system has been set up to work with a bill from that particular biller (if the bill is recognized as a bill from a biller which is included the walk-in bill payment system's database) the customer is presented with a screen displaying the amount of the bill and the consumer is asked how the consumer proposes to make payment. In the Krouse et al. patent, the consumer uses a debit card, enters the PIN associated with the debit card, and the walk-in bill payment system debits the consumer's bank account which is tied to the debit card and electronically transmits payment to the biller. It is important to differentiate presentment from payment; the Krouse et al. patent deals solely with payment, and is completely incapable of presenting a bill electronically.

The 35 U.S.C. § 103 Rejections Fail to Present a Prima Facie Case of Obviousness

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17,

148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Such reason must stem from some teaching, suggestion, or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 22y USPQ 657, 664, (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The statements made by the Examiner in the December 22, 2004, Office Action demonstrate the fact that the Examiner has used impermissible hindsight to make the combination of the Kolling et al. and Krouse et al. references: "Since Kolling deals with electronic statements which are financial documents, an ordinary skill artisan would have turned to the teachings of Krouse et al for these above noted teachings [the claim limitations not present in Kolling et al.]" December 22, 2004, Office Action, Page 4. In other words, since Reference A deals with Technology A, one of ordinary skill would

have turned to the teachings of Reference B for the elements of the claims which Reference A does not include. This is absurd in the extreme, since there is absolutely no motivation whatsoever provided in this statement. The Examiner is essentially saying that it is obvious because it is obvious; without a doubt, this is the use of impermissible hindsight, using Applicants' claims as a blueprint to search for pieces in utterly unrelated prior art references.

Continuing, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Krouse et al into the system of Kolling in order to facilitate the conversion of paper bills into electronic format for presenting to a customer." What this is saying is that it would be obvious to incorporate Technology B of Reference B into the system of Reference A in order to do what the Examiner believes Technology B does, but doing it in the system of Reference A. This again is an implicit use of impermissible hindsight to provide elements missing from the primary reference from another unrelated reference without a single word as to why one skilled in the art would have done so.

Further, the Examiner has completely misinterpreted the Krouse et al. reference, since it does not "facilitate the conversion of paper bills into electronic format for presenting to a customer." Far from it -- the Krouse et al. reference only allows the recipient of a paper bill to take that paper bill and the recipient's debit card and physically walk into a store or business that has a terminal from the Krouse et al. walk-in bill

payment system and pay the bill in that store or business using the debit card. Thus, the Krouse et al. system is not and indeed can not be part of a bill presentment system. It is a walk-in bill payment system which is completely unrelated to the electronic bill presentment system of Kolling et al. The December 22, 2004, Office Action completely mischaracterizes the nature of the Krouse et al. walk-in bill payment system, which teaches nothing which is even remotely relevant to an electronic bill presentment system. In the world of Krouse et al., bills are always presented to the customer in paper. In the world of Krouse et al., customers never access an electronic bill presentment and payment system. Instead, in the world of Krouse et al., customers take their paper bills, travel to a store or business that has a Krouse et al. walk-in bill payment system, and pay their bill at the store or business with a debit card.

Applicants submit that one skilled in the art would have found absolutely no reason of any kind to combine the electronic bill-only bill presentment system of Kolling et al. with the walk-in bill paper bill payment system of Krouse et al. The December 22, 2004, Office Action failed to point to either a teaching in or an inference relating to either of the cited references which could lead one skilled in the art to combine them together. In point of fact, the references are completely unrelated and provide neither any teaching nor any suggestion, nor suggest any possible inference which could justify the combinations of references. At the conclusion of the Examiner's arguments, it is readily apparent that the obviousness rejection failed to meet even the most basic of the

requirements established by the case law in pointing to any justification for making any of the combinations of references.

The bare recitation of references which are alleged (incorrectly) to disclose each of the elements of the claims in the December 22, 2004, Office Action without any reason that one skilled in the art would make the combination constitutes the use of hindsight and is per se improper. As stated by the Court of Appeals for the Federal Circuit, "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." In re Dembicza, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). This clear and inappropriate use of hindsight knowledge to establish obviousness is impermissible, and the inescapable conclusion is that the obviousness rejection is an improper combination of prior art references, and is not sustainable. Accordingly, Applicants submit that the Section 103(a) rejections of Claims 1, 9, 13, 16, 24, and 28 must be withdrawn, and such withdrawal together with the allowance of independent Claim 1, 9, 13, 16, 24, and 28, as well as the claims depending therefrom, is respectfully solicited.

The Examiner's Allegations of What Is Obvious in the Field of the Invention Are Unsupported And Fail to Comply With USPTO Requirements for a Rejection

On Page 4 of the December 22, 2004, Office Action, the Examiner repeatedly asserts that aspects of the claims are obvious without making any citation of prior art to support the allegations: "As per these limitations [the limitations of the independent

claims which are not present in the Kolling et al. reference] the Examiner notes that transmitting or mailing paper bills to Kolling for further processing and presenting to a customer in an electronic format would have been obvious to one of ordinary skill in the art to do at the time of the invention. Nothing in Kolling prevents Kolling from accepting paper bills for conversion to electronic formats. ... Thus, transmitting paper bills to the system of Kolling would have been readily acceptable through the regular mail system."

This is per se error on the part of the Examiner, and in view of this fact the rejections of the December 22, 2004, Office Action cannot stand. The Examiner has not established in any way that he is an expert in the field, and as such is absolutely unqualified to opine as to the obviousness of making modifications which are not taught in the art which has been cited by the Examiner. This is an unsupported assertion without a shred of documentation or other evidence, and constitutes a further indication that the rejection of Claims 1-30 is improper and must be removed.

Continuing, on Page 4 of the December 22, 2004, Office Action: "In so doing, Kolling would have scanned the received paper bills, do further image processing and cleaning the scanned paper bills which would have also been done for indexing and record keeping purposes. ... These steps are well known in the art of image processing and analysis of scanned financial documents." This assertion is made without any statutory, regulatory, or M.P.E.P. basis whatsoever, particularly in view of the fact (which has been conceded on Page 3 of the December 22, 2004, Office Action) that the

Kolling et al. reference does not receive, scan, work with, or otherwise use paper bills or any other paper documents in any way. This completely unsupported assertion in the December 22, 2004, Office Action is directly contravenes well-established U.S. Patent and Trademark Office procedures. Again, the Examiner has not in any way established an expertise in the field, and this thus represents an unsupported (and unsupportable) modification of references which is inadequate to teach the invention as presently claimed.

Thus, Applicants assertion that the rejection of independent Claims 1, 9, 13, 16, 24, and 28 fails to teach all of the elements of these claims stands as being substantively unchallenged, and Applicants thus respectfully solicit the removal of the Section 103(a) rejections of Claims 1, 9, 13, 16, 24, and 28 on this ground, and the allowance of independent Claim 1, 9, 13, 16, 24, and 28, as well as the claims depending therefrom.

**The Combination of References Cited in the 35 U.S.C.
§ 103(a) Rejection Does Not Teach the Claimed Invention**

There are two separate errors in the Section 103(a) rejection in the December 22, 2004, Office Action based upon the Kolling et al. and Krouse et al. references. The first error is that both of these references are mischaracterized as teaching that which they quite simply do not in fact teach. The second is that the combination, even if it were a proper Section 103(a) combination rejection (which it is not), fails to teach all of the elements of independent Claims 1, 9, 13, 16, 24, and 28.

With regard to the Kolling et al. reference, the December 22, 2004, Office Action repeats an error made earlier in the January 13, 2004, Office Action. That error relates to the word "template," with the Examiner asserting that Kolling et al. teaches "billing information ... extracted using a predefined template." December 22, 2004, Office Action, Page 3. While Kolling et al. uses the word "template," it is used with a completely different meaning than its meaning in the claims of the present application. Kolling et al. uses a data table referred to as a template for each biller, with each Kolling et al. template being nothing more than a list of the data fields which appear in a paper statement from that biller to the consumers which are its customers. Different billers have different data fields, and hence need different Kolling et al. templates. The batched electronic billing data for each biller is sorted for individual consumers, and the sorted batched electronic billing data is used to generate electronic billing statements, which are then sent to the appropriate consumers.

In stark contrast, the present patent application uses the word "template" as a description for the "zone information for locating the required billing summary data ... on the paper bill. ... The required billing summary data zones include bill date, bill amount, minimum due, due date, account number and consumer name and address." Specification, page 19, line 13-15 and 18- 20, and Fig. 4. Thus, it is clear that the word "template" as used by Kolling et al. has a completely different meaning than the use of the word "template" in the present invention.

The Examiner is reminded of the long-standing and well-established rule that a patentee can be his or her own lexicographer, and it is clear that the word "template" as used in the claims of the present patent application is used in a completely different sense than the word "template" is used in the Kolling et al. reference. Thus, the reliance on the Kolling et al. reference to teach a template library to identify the type of bill is baseless and incorrect at best, and it is in utter disregard of the readily apparent wide disparity in meanings occasioned by the use of the same word to describe completely different concepts. The plain fact is that the Kolling et al. reference does not teach what it has been asserted to teach in the December 22, 2004, Office Action.

With regard to the Krouse et al. reference, the December 22, 2004, Office Action has done far more than merely misconstrue the meaning of a single, albeit highly significant, word -- rather, the December 22, 2004, Office Action completely ignores the entire purpose, character, and operation of the Krouse et al. reference. The Krouse et al. reference has nothing whatsoever to do with electronic bill presentment, which is the subject of the claimed invention of the present patent application. The system of Krouse et al. is instead a walk-in bill payment system in which the customer always receives only a paper bill. In the system as claimed in the present invention, the customer gets only electronic bills. The Krouse et al. walk-in bill payment system requires the customer to physically travel to a store or business having a Krouse et al. walk-in bill payment system. The system of the present invention, of course, allows customers to receive and

pay bills electronically from any location. The Krouse et al. walk-in bill payment system scans the bill and NEVER presents it electronically, in contrast to the system of the present invention, which presents the bill electronically. The Krouse et al. walk-in bill payment system displays the bill payment information on a monitor at the store or business having a Krouse et al. walk-in bill payment system, and then requires the customer to enter debit card information and a PIN at the store or business. The plain fact is that the Krouse et al. is irrelevant to the claimed invention of the present patent application.

For example, Krouse et al. can not receive paper bills for a customer from a biller. (Kolling et al. does not work with or use paper bills in any way, but instead completely replaces such paper bills with electronic bills which are created from electronic information supplied by the billers to the BSP.) That specific limitation is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28: see Claim 1 -- "receiving at least one paper bill for said customer from at least one of said billers;" Claim 9 -- "receiving and processing a paper bill for a customer;" Claim 13 -- "receiving a paper bill for a customer;" Claim 16 -- "means for receiving at least one paper-based bill for said customer from at least one of said billers;" Claim 24 -- "means for receiving a paper bill for a customer;" and Claim 28 -- "means for receiving a paper bill for a customer."

Applicants assert that it is plain that the limitation of receiving (or having means for receiving) at least one paper bill for a customer from a biller, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, the § 103 rejection is erroneous, and Applicants respectfully request that it be withdrawn and that independent Claims 1, 9, 13, 16, 24, and 28, as well as the claims depending thereupon, be allowed.

Similarly, the limitation of scanning a paper bill which has been received (by the service provider) for a customer to generate electronic image information is present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 and is not taught by the cited references (while Krouse et al. may teach scanning a paper bill which is physically brought into a store or business having the Krouse et al. walk-in bill payment system, it does not receive paper bills for customers and thus by definition cannot scan such bills): see Claim 1 -- "scanning said at least one paper bill received for said customer to generate electronic image information;" Claim 9 -- "scanning said paper bill received for said customer to generate electronic image information;" Claim 13 -- "scanning said paper bill received for a customer to generate electronic image information;" Claim 16 -- "means for scanning said at least one paper bill received for said customer to generate electronic image information;" Claim 24 -- "means for scanning said paper bill received for said customer to generate electronic image

information;" and Claim 28 -- "means for scanning said paper bill received for said customer to generate electronic image information."

Applicants assert that it is plain that the limitation of scanning a paper bill received for a customer to generate electronic image information, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, it is apparent that that the § 103 rejection of is erroneous and must be withdrawn, and Applicants respectfully request that independent Claims 1, 9, 13, 16, 24, and 28, as well as the claims depending thereupon, be allowed.

The limitation of validating the billing information extracted from the scanned paper bill is also present in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 and is not taught by the cited references: see Claim 1 -- "validating the extracted billing information generated from said scanned paper bill;" Claim 9 -- "validating the extracted billing information generated from said scanned paper bill;" Claim 13 -- "validating the extracted billing information generated from said scanned paper bill;" Claim 16 -- "means for validating the extracted billing information generated from said scanned paper bill;" Claim 24 -- "means for validating the extracted billing information generated from said scanned paper bill;" and Claim 28 -- "means for validating the extracted billing information generated from said scanned paper bill."

Applicants assert that it is plain that the limitation of validating the billing information extracted from the scanned paper bill, which is included in each and every one of independent Claims 1, 9, 13, 16, 24, and 28 is not taught or suggested in any of the references relied upon by the Examiner in the rejection under 35 U.S.C. § 103. As such, it is apparent that that the § 103 rejection is erroneous, and Applicants respectfully request that the rejection be withdrawn and that independent Claims 1, 9, 13, 16, 24, and 28, as well as the claims depending thereupon, be allowed.

For the simple reason that there are no less than three elements of each of independent Claims 1, 9, 13, 16, 24, and 28 that are not taught or suggested by the cited references, Applicants maintain that the combination of Kolling et al. and Krouse et al. does not teach the claimed invention. Claims 2-8, 10-12, 14, 15, 17-23, 25-27, 29, and 30, which are dependent claims, are all allowable as depending from allowable base claims, and contain further limitations which are not taught or suggested by the references (which will not be elaborated upon herein in view of the clear patentability of independent Claims 1, 9, 13, 16, 24, and 28). Claims 1-30 are patentable over the references cited in the December 22, 2004, Office Action, and the rejection must be withdrawn.

Conclusions

Accordingly, Applicants believe that Claims 1-30 are patentable at this time. These claims remain pending following, and are believed to be in condition for allowance

at this time. As such, Applicants respectfully request reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicants' undersigned attorney at the number listed below.

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